

**REMARKS**

**Specification**

The Examiner has objected to the disclosure because of the following informalities: The first sentence of the specification should be amended to provide the most current status of the related application. Applicants have added the most current status of U.S. Application Serial No. 10/472,295 filed September 18, 2003. That is, Application Serial No. 10/472,295 filed September 18, 2003 issued on September 5, 2006 and received Letters of Patent No.: 7,101,372.

Claim Rejections

**35 USC §103**

With respect to the Examiner's rejection of claims 1 and 2 under 35 USC §103(a) as being unpatentable over U.S. Patent No. H1,904 to Yates, in view of the teaching of U.S. Patent No. 5,258,006 to Rydell et al., Applicants respectfully traverse this rejection.

According to § 2143.03 of the MPEP, [t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In Re Royka* 180 USPQ 580 (CCPA 1974). For the reasons stated hereinafter, it is Applicants' position, that all the claim limitations of independent claims 1 and 2, of the above-referenced application, are not taught or suggested, either expressly or implicitly, by any of the above cited prior art.

In the present Office Action, in view of the Yates disclosure, the Examiner reasserts, with the same vigor, the same arguments that were made in the last Office Action, dated October 20, 2006. At this time, Applicants respectfully traverse the Examiner's reassertions and respectfully submit that the rebuttal arguments and/or remarks that were made by the Applicants, in the amendment dated January 12, 2007, apply equally and with the same force, to the present office action.

Additionally, the Examiner avers that, although Yates fails to disclose channels extending through the endoscope for providing electrical conductors for connection to the jaw members, as Applicants' disclosure, it would have been obvious to those skilled in the art to combine the teachings of Rydell et al. with the teachings of Yates. At this time, Applicants respectfully traverse this assertion.

In order to expedite the above-referenced application through the prosecution process, Applicants have amended claims 1 and 2 to clearly distinguish Applicants' present disclosure from the above cited prior art, namely Rydell et al. More particularly, claims 1 and 2 as currently amended recite "[...] a surgical instrument...providing a pair of opposing channels, said channels extending **along an outer periphery of said shaft [...]**" Support for this amendment can be found beginning on line 20 of page 31 of the Applicants' present disclosure.

Rydell et al. does not teach or suggest of a surgical instrument having a shaft with channels extending along an outer periphery of said shaft. Instead, the shaft (e.g., inner tube **12**) taught in Rydell et al. has a pair of channels (e.g., lumens **23**) located therein and that extend the entire length thereof. See col. 6, lines 1-3 and FIG. 3, of the Rydell et al. disclosure.

This configuration is essential for the electrosurgical apparatus, as disclosed

in Rydell et al., to function and operate as intended. That is, "[t]he squeezing action of the jaws 26 is accomplished by moving the inner tube 12 in the distal direction inside the lumen of the outer tube 11. The leads 13 are fastened to the free-wheeling connector 4, which cannot move translationally, so the inner tube 12 slides over them, relative to the stationary conductive leads 13."

Thus, if one were to configure the inner tube 12 with channels located on an outer periphery of channel 12, the squeezing action of the jaws 26 could not be accomplished without rubbing over the lead 13, which, as can be readily appreciated, could cause damage to the leads 13 leading to electrical failure.

In view of the above amendments and/or arguments, it is Applicants' position that neither Yates nor Rydell et al. or any combination thereof teach or suggest all of the claim limitations of the Applicants' present disclosure. As a result independent claims 1 and 2 should be in condition for allowance.

### **35 USC §103**

With respect to the Examiner's rejection of claim 3 under 35 USC §103(a) as being unpatentable over U.S. Patent No. H1,904 to Yates, in view of the teaching of U.S. Patent No. 5,258,006 to Rydell et al. and in further view of the teaching of U.S.

Patent No. 5,258,006 to Chen et al., Applicants respectfully traverse this rejection.

As mentioned above, according to § 2143.03 of the MPEP, [t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In Re Royka* 180 USPQ 580 (CCPA 1974).

Chen et al. does not cure the deficiencies of Yates or Rydell et al. Thus, for at least the same or similar reasons stated above, it is Applicants' position, that all the claim limitations of independent claim 3, of the above-referenced application, are not taught or suggested, either expressly or implicitly, by any of the above cited prior art either taken alone or in combination.

### **Double Patenting**

In the prior Office Action, Claims 1-2 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the pending claims of co-pending U.S. Patent Application No. 10/849,432, in view of the teaching of Eggers et al. (5,484,436).

The terminal disclaimer that was previously filed on January 16, 2007 was reviewed and NOT accepted, because as the Examiner avers the attorney who signed the terminal disclaimer, Edward Meagher, was not of record. Enclosed

herewith is a copy of the COMBINED DECLARATION AND POWER OF ATTORNEY, filed on August 5, 2004. As can be clearly evidenced from COMBINED DECLARATION AND POWER OF ATTORNEY, Edward Meagher is an Attorney of record for the present application.

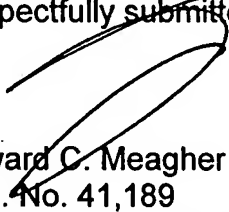
In view of the attached COMBINED DECLARATION AND POWER OF ATTORNEY. It is the Applicants' position, that the terminal disclaimer filed on January 16, 2007 is correct and should be sufficient to obviate the provisional nonstatutory double patenting rejection over the pending patent application. As mentioned in the prior Office Action, the Assignee of the instant application namely, Sherwood Services AG, owns 100% interest in the present application and U.S. Patent Application No.: 10/849,432.

**CONCLUSION**

It is respectfully submitted that all of the claims now pending in this application, namely Claims 1, 2, and 3 are now in condition for allowance. Accordingly, early and favorable consideration of this application is respectfully requested. It is respectfully submitted that none of the references of record considered individually or in combination anticipate, disclose or suggest the claims as presently amended. Accordingly, withdrawal of the rejections is respectfully requested.

In view of the foregoing amendments and remarks, reconsideration of the rejections and objections and allowance of the claims are earnestly solicited.

Respectfully submitted,

  
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